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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,910	05/23/2001	Sanjay M. Kuttappa	DSCK-1158-D1	3334

7590
Lorusso & Loud
440 Commercial Street
Boston, MA 02109

EXAMINER

GORDON, RAEANN

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 10/06/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,910

Applicant(s)

KUTTAPPA, SANJAY M.

Examiner

Raeann Gorden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The newly added limitation requiring the heavy weight filler to be no more than 1.95% volume of the core is not enabling. As support applicant has cited a table on page 7. The table discloses 1.95% by volume of **zirconium dioxide** present in the core and 0.48% by volume of **tungsten**; the remaining values between zero and 1.95% as claimed are not enabling. Furthermore, the values are only relevant to the zirconium dioxide and tungsten; quantities are not given for the remaining heavy fillers claimed by applicant, i.e, there are no quantities for bismuth, copper, bismuth oxide, nickel, cobalt, iron, steel, tin, chromium, bismuth subcarbonate, cupric oxide, barium tungstate, and cuprous oxide.

Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. The newly added limitation requiring the heavy weight filler to be no more than 1.95% volume of the core is not enabling. As support applicant has cited a table on page 7. The table discloses 1.95% by volume of **zirconium dioxide** present in the core and 0.48% by volume of **tungsten**; the remaining values between zero and 1.95% as claimed are not enabling. Furthermore, the values are only relevant to the zirconium dioxide and tungsten; quantities are not given for the remaining heavy fillers claimed by applicant, i.e, there are no quantities for bismuth, copper, bismuth oxide, nickel, cobalt, iron, steel, tin, chromium, bismuth subcarbonate, cupric oxide, barium tungstate, and cuprous oxide.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan (5,833,553) in view of Tanaka et al (5,730,663) and Yabuki et al (5,482,285). Regarding claims 1 and 12, Sullivan discloses a core comprising a high cis-1, 4 polybutadiene and a heavy weight filler such as tungsten, bismuth, copper, iron, etc. and a cover layer. (col 3, line 15-25). Sullivan discloses the polybutadiene has a high cis structure but does not disclose the percentage. However, Tanaka teaches a core comprising a polybutadiene with a cis structure of at least 80% (col. 3, line 20). Sullivan

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also fails to disclose the exact amount of the heavy weight filler in the core. However, Yabuki teaches heavy weight fillers in the amount from 3 to 300 parts by weight depending on the desired specific gravity. Regarding claims 2, Sullivan discloses the core has a PGA compression of 85 or less and a coefficient of restitution of at least 0.700 (col 1, line 65-col 2, line2). Regarding claim 3, Sullivan further discloses a solid core with elastic windings surrounding (col 4, lines 17-20). Regarding claim 4, Sullivan discloses the core has a PGA compression of 85 or less and a coefficient of restitution of at least 0.700 (col 1, line 65-col 2, line2). Regarding claims 5 and 6, the heavy weight fillers include tungsten, bismuth, copper, and iron. Regarding claim 7, Sullivan discloses the core ingredients are mixed, formed into slugs and molded (col 8, lines 15-40). The core may also include regrind (col. 19). Regarding claims 8-10, the heavy weight fillers include tungsten, bismuth, copper, and iron. Regarding claim 11, the core includes peroxide (table 6). Regarding claim 13, the heavy weight fillers include tungsten, bismuth, copper, and iron. Regarding claim 14, the core includes peroxide (table 6). Regarding claim 15 and 18, the core may also include regrind (col. 19). Regarding claim 16, Sullivan discloses the core has a PGA compression of 85 or less and a coefficient of restitution of at least 0.700 (col 1, line 65-col 2, line2). Regarding claim 17, 19, 20, and 21, the core ingredients include zinc oxide, zinc diacrylate, zinc stearate, and peroxide. Regarding claims 22 and 23, Sullivan discloses the core has a PGA compression of 85 or less and a coefficient of restitution of at least 0.700 (col 1, line 65-col 2, line2). Regarding claims 24 and 27, the golf ball has a PGA compression

lower than 103.6 (Table 6). Regarding claims 25 and 26, the golf ball has a PGA compression lower than 97.3 (Table 6). See previous claim rejections for claims 28-31.

Response to Arguments

Applicant's arguments with respect to claims 1-31 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments regarding the 112, first paragraph rejection has been considered but is not persuasive. Applicant is attempting to claim a range that was not previously presented in the specification. In order to overcome the rejection applicant is required to show the following in the original specification: 1) a heavy weight filler in the amount of no more than 1.95% and 2) the quantities for the amounts of bismuth, copper, bismuth oxide, nickel, cobalt, iron, steel, tin, chromium, bismuth subcarbonate, cupric oxide, barium tungstate, and cuprous oxide present in the core.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

A handwritten signature in black ink, appearing to read 'Raeann Gordon', is written over the printed name.

Raeann Gordon
Examiner
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rg
October 1, 2003